

REMARKS/ARGUMENTS

Claims 1-120 are pending in the present application.

This Amendment is in response to the Office Action mailed January 9, 2008. In the Office Action, the Examiner rejected claim 33 under 35 U.S.C. §112, first paragraph; claims 1-120 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 33 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Specifically, the Examiner states that it is not clear to the Examiner how a sensor capable of intermittent coupling to a first transmitter of the plurality of transmitters to receive the respective location broadcast by the first transmitter (Office Action, page 3, lines 1-3). Applicant respectfully disagrees for the following reason.

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir.1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that **the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.** *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). Furthermore, as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation

to the entire scope of the claim, then the enablement requirement of **35 U.S.C. 112** is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Claim 33 focuses on a sensor coupled to a first transmitter to receive the respective location broadcast by the first transmitter. Clearly, a sensor may act as a receiver to receive the information broadcast by the transmitter, including the transmitter's location. The Specification provides ample support for the claim, including at least one method for making and using the claimed invention. See, for example, Specification, page 9; lines 4-7, lines 16-23; Fig. 1.

The Examiner has not shown that if any experimentation is necessary, it is undue. Furthermore, the Examiner has not shown that the specification does not disclose at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, is improperly made.

Therefore, Applicants respectfully request the rejection under 35 U.S.C. §112 be withdrawn.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected:

1. Claims 1-5, 7, 10-15, 17, 61-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,169,895 issued to Buhrmann et al. ("Buhrmann") in view of U.S. Patent No. 6,148,178 issued to Nelms et al. ("Nelms") and further in view of U.S. Publication No. 2003/0093218 issued to Jones ("Jones") and US Patent No. 4,847,777 issued to Gerhart et al. ("Gerhart");
2. Claims 6, 16, 66, 76, 86, 96, 106, and 116 under 35 U.S.C. §103(a) as being unpatentable over Buhrmann in view of Nelms and Jones, and further in view of Gerhart U.S. Patent No. 6,084,862 issued to Bjork et al. ("Bjork");
3. Claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120 under 35 U.S.C. §103(a) as being unpatentable over Buhrmann in view of Nelms and further in view of Jones, Gerhart, and U.S. Patent No. 6,603,977 issued to Walsh et al. ("Walsh");
4. Claims 21-32, and 54-60 under 35 U.S.C. §103(a) as being unpatentable over Walsh et al. ("Walsh") in view of Jones and further in view of Gerhart.

5. Claims 33-37 under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of Jones, and further in view of Gerhart and US Patent No. 5,737, 328 issued to Norman (“Norman”); and
6. Claims 38-53 under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of Jones, and further in view of Norman.

Applicant respectfully traverses the rejections and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004). Applicants respectfully submit that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” *MPEP* 2141. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* 127 S.Ct. at 1741, quoting *In re Kahn*, 441 F.3d 977, 988

(Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

1. Claims 1-5, 7, 10-15, 17, 61-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115:

Buhrmann discloses a landline-supported private base station for collecting data and switchable into a cellular network. When an incoming call is directed to a particular mobile station, the private base station detects the ring and sends an alerting signal to the registered mobile station (Buhrmann, col. 6, lines 19-21, 28-30). A RF circuit performs the radio frequency signal processing (Buhrmann, col. 7, lines 21-23). An RF codec performs analog-to-digital and digital-to-analog conversions of the I and Q signals in the RF circuit (Buhrmann, col. 7, lines 21-23). A mobile station obtains registration with a private base station (Buhrmann, col. 6, lines 8-10). The registration involves updating the mobile station's temporary line dialing number (Buhrmann, col. 7, lines 14-16). An ordered position information is treated as the local unique address or a sub-address by the private base station 20 (Buhrmann, col. 7, lines 59-62).

Nelms discloses a selective call message formatting. A receiver 204 is coupled to the antenna 202 to receive the radio frequency signals (Nelms, col. 5, lines 67; col. 6, lines 1). A demodulator 206 is coupled to the receiver 204 to recover any information signal present in the RF signals (Nelms, col. 6, lines 1-4). A decoder 212 decodes the signal for the status/information field 402 to determine if the message contains individual selective call messages or information services data (Nelms, col. 6, lines 24-27).

Jones discloses a system and method for an advance notification system for monitoring and reporting proximity of a vehicle. The contact information can be manually entered or downloaded into the user database 78 in order to activate a user for the system 10 (Jones, paragraph [0063], lines 1-4). A request for activation is a request for the user to be entered into the system 10 (Jones, paragraph [0063], lines 3-5). A message manager 82 prompts the user to indicate whether the call is an activation, an update of an activation, or a request for travel data (Jones, paragraph [0117], lines 6-8).

Gerhart discloses a security and alarm system employing a particular pulse width discriminator. When an alarm condition is being signaled, the received pattern will match the data pattern expected in the event of an alarm condition. A video display IC is used to display a transmitted message. This message will normally contain the location of the transmitting station, pertinent telephone numbers and other data which the owner of the transmitting station has given it to transmit (Gerhart, col. 6, lines 1-7).

Buhrmann, Nelms, Jones, and Gerhart taken alone or in combination, do not disclose, either expressly or inherently, suggest, or render obvious, at least one of: (1) a decoder to decode an activation message, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the decoder generating an activation command; (2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation command, and (3) the information message containing a geographical location of a transmitter containing the transmitting unit, as recited in claims 1, 81, and 101; or (1) a decoder to decode an activation message, the activation message being sent from an activator in response to a telephony call, the decoder generating an activation command; (2) a receiving unit coupled to the decoder to receive a signal containing an information message upon enabled by the activation command, the information message being sent from a transmitter according to a communication protocol via a communication medium, and (3) the information message containing a geographical location of the transmitter, as recited in claims 11, 91, and 111; or (1) decoding an activation message to generate an activation command, the activation message being sent from a request subsystem via a communication medium in response to a telephony call; (2) transmitting a signal modulated from an information message responsive to the activation command, by a transmitting unit, to a receiver using a communication protocol, and (3) the information message containing a geographical location of a transmitter containing the transmitting unit, as recited in claim 61; or (1) decoding an activation message to generate an activation command, the activation message being sent from an activator in response to a telephone call; (2) receiving a signal containing an information message upon enabled by the activation command, the signal being sent from a transmitter according to a communication protocol, and (3) the information message containing a geographical location of the transmitter, as recited in claim 71.

Buhrmann merely discloses a codec to perform A/D and D/A conversions and modulation for the transmission path (Buhrmann, col. 7, lines 33-38), not a decoder to decode an activation message. Performing A/D and D/A conversions only involve transformation the signal from one domain (e.g., analog) to another domain (e.g., digital). In addition, the I and Q signals of which the conversions are performed are not related to an activation message. They merely represent the RF signal from the mobile stations (Buhrmann, col. 7, lines 21-32).

In addition, Buhrmann merely discloses detecting the ring for an incoming call when an incoming call is directed to a particular mobile station (Buhrmann, col. 6, lines 19-21, lines 28-35), not sending an activation message in response to a telephony call. The private base station merely sends an alerting signal to the mobile station (Buhrmann, col. 7, lines 28-30). In other words, it acts like a switch to connect an incoming call to the mobile station. It does not perform sending any message to a decoder.

Furthermore, Buhrmann merely discloses the RF unit to produce the I and Q signals for an RF codec (Buhrmann, col. 7, lines 21-32), or to perform modulation for the transmission path (Buhrmann, col. 7, lines 37-38), transmitting a signal modulated from an information message responsive to the activation command. Performing modulation merely modulates a signal according to some communication scheme. It does not involve an information message. Furthermore, it does not modulate the signal in response to an activation command. The Examiner recites the connection between the microprocessor 24 and the item 26 in Fig. 2 (Final Office Action, page 8, paragraph number 5). However, this connection merely shows the detection of the ring. It does not show the activation command and the information message.

Moreover, Buhrmann merely discloses registering mobile stations using the dialing number (Buhrmann, col. 6, lines 15-17), or the address or a sub-address (Buhrmann, col. 7, lines 59-61). Location, according to Buhrmann's teachings, merely refers to the address or the number, not the geographical location associated with a transmitter. To clarify this aspect of the invention, claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, and 111 have been amended.

Nelms merely discloses a decoder decoding the signal for status/information to determine if the message contains individual selective call messages or information services data (Nelms, col. 6, lines 24-27), not an activation message. The status/information field 402 identifies the

type of information or an application other than the information services (Nelms, col. 4, lines 5-9). Therefore, it is not related to an activation message.

Furthermore, Nelms' decoder is used to decode type of information services, such as stock market, weather, sports, news, etc. (Nelms, col. 1, lines 20-22). None of these information services is related to the geographical location information of a transmitter.

Jones merely discloses activating a user as entering the user into the system (Jones, paragraph [0063], lines 3-4; paragraph [0066], lines 3-5). An activation request, therefore, is a request to enter the user into the system, not a request for geographical location information. Furthermore, the activation request is generated by the user, not by a request subsystem in response to a telephony call.

Gerhart merely discloses a transmitted message normally containing the location of the transmitting station (Gerhart, col. 6, lines 1-7), not an information message containing a geographical location of a transmitter containing the transmitting unit. First, the transmitted message is displayed when an alarm condition is signaled (Gerhart, col. 6, lines 1-2), not in response to a telephony call. Second, a transmitting station is not a transmitter. The transmitting station may be a house, a dwelling, or a building (Gerhart, col. 1, lines 26-29). Third, the location may not be a geographical location. It may be a number coded to indicate the position of the transmitting station in a display of a network of stations.

2. Claims 6, 16, 66, 76, 86, 96, 106, and 116:

Buhrmann, Nelms, and Jones are discussed above.

Bjork discloses a time dispersion measurement in radio communications systems. A radio channel 203 is modeled to include a Finite Impulse Response (FIR) filter 401, the output of which is added to a white noise signal. The purpose of the white noise is to ensure that the model models all of the interference in the radio channel (Bjork, col. 7, lines 15-21).

Buhrmann, Nelms, Bjork, and Jones, taken alone or in any combination, do not disclose, suggest, or render obvious, at least one of (1) a decoder to decode an activation message, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the decoder generating an activation command; (2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation command; (3) the

transmitting unit comprises a modulator to modulate the information message according to a modulating scheme; (4) the modulating scheme is compatible with a sound signal; and (5) the modulating scheme uses a pseudo random binary sound (PRBS).

As discussed above, Buhrmann, Nelms, and Jones do not disclose or suggest elements (1) and (2) above. Therefore, a combination of Buhrmann, Nelms, and Jones with any other references in rejecting claims 6, 16, 66, 76, 86, 96, 106, and 116 is improper.

Furthermore, Bjork merely discloses modeling a radio channel, not modulating. Modeling is used to calculate the most probable transmitted data as part of a receiver. In contrast, modulating is used to transmit data, which is the opposite of receiving data. Moreover, Bjork merely discloses using the white noise to model all the interference in the radio channel (Bjork, col. 7, lines 15-21), not the information message. Interference includes co-channel interference, adjacent interference, thermal noise, and any other interference. In contrast, information message contains the information, which is the opposite of the interference.

3. Claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120:

Buhrmann, Nelms, Jones, and Gerhart are discussed above.

Walsh discloses a location information system for a wireless communication device and method therefor. The location information represents locations of predetermined areas, such as floors, rooms, hallway, etc. (Walsh, col. 8, lines 38-40). In an E911 application, the wireless communication unit sends the location information at least one of before, during, and after the wireless communication device communicates an emergency telephone call to a public safety answering point (Walsh, col. 11, lines 42-46).

Buhrmann, Nelms, Jones, Gerhart, and Walsh, taken alone or in any combination, do not disclose, suggest, or render obvious, at least one of (1) a decoder to decode an activation message, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the decoder generating an activation command; (2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation command; (3) the information message includes a location identifier corresponding to location of the transmitting unit; (4) the location identifier includes global positioning system (GPS) information, as recited in claims 8, 18, 68, 78, 88, 98, 108, and 118; and (5) the telephony call is

made by a person located in proximity of the transmitter, as recite in claims 9, 19, 69, 79, 89, 99, 109, and 119; and (6) the telephony call is an emergency call using an emergency call number, as recited in claims 20, 70, 80, 90, 100, 110, and 120.

As discussed above, Buhrmann, Nelms, Jones, and Gerhart, taken alone or in any combination, do not disclose or suggest elements (1) and (3) above. Therefore, a combination of Buhrmann, Nelms, Jones, and Gerhart and any other references in rejecting claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120 is improper.

Furthermore, Buhrmann merely discloses a private base station collecting data including temperature readings, energy usage (Buhrmann, col. 2, lines 21-23), not location information of the transmitting unit. Similarly, Nelms merely discloses presenting messages in a consistent manner across a number of selective call devices (Nelms, col. 1, lines 31-35), not information location of the transmitter. Accordingly, neither Buhrmann nor Nelms discloses or suggests location information; and therefore location identifier; and the telephony call being made by a person located in proximity of the location of the transmitting unit. The Examiner even concedes that a combination of Buhrmann, Nelms, Jones, and Gerhart does not specifically disclose the location identifier including the global positioning system (GPS) information (Office Action, page 8, lines 5-6), and the telephony call being made by a person located in proximity of the location of the transmitting unit (Office Action, page 8, lines 14-16). Accordingly, the combination of Buhrmann, Nelms, Jones, and Gerhart with Walsh in rejecting claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120 is improper because there is no motivation to combine them.

Moreover, Walsh merely discloses the location information associated with a plurality of predetermined areas in the facility such as a floor, a room, etc. (Walsh, col. 10, lines 42-44, lines 54-59), not the location information of the transmitters. Walsh does not disclose or suggest the telephone call made by a person located in proximity of the location of the transmitting unit. Walsh merely discloses location descriptions associated with a plurality of predetermined areas 210-213 (Walsh, col. 8, lines 18-21). Since these are predetermined areas, they cannot be associated with a person making a telephone call who may be located outside these areas.

4. Claims 21-32, and 54-60:

Walsh, Jones, and Gerhart are discussed above.

Walsh, Jones, and Gerhart, taken alone or in combination, do not disclose, either expressly or inherently, suggest, or render obvious, at least one of: (1) A network comprising a plurality of commonly coupled location transmitters, each transmitter comprising a transmission unit to broadcast a signal modulated from an information message containing respective geographical location information upon receipt of an activation request that requests the geographical location information, the activation request being generated from a request subsystem in response to a telephony call, as recited in claim 21; (2) a receiver to receive geographical location information associated with a transmitter, the geographical location information being transmitted by the transmitter in response to a telephony call; (3) a processor coupled to the receiver to process the geographical location information and to enable the receiver to receive the geographical location information; (4) a network interface coupled to the processor to transmit the geographical location information over a network, as recited in claims 54 and 57; (5) a location sensor to provide geographical location information embedded in an information message in response to a telephony call; (6) a determination unit coupled to the sensor, the determination unit to determine the geographical location information from the information message; and (7) a network interface coupled to the determination unit to selectively transmit the geographical location information over a network, as recited in claim 60.

Walsh merely discloses a wireless communication unit 209 sending the location information to a wireless communication device 104, such as a cellular telephone device (Walsh, col. 8, lines 42-44), not upon receipt of an activation request from a request subsystem. The wireless communication unit sends the location information at least one of before, during, and after the wireless communication device communicates an emergency telephone call to a public safety answering point (Walsh, col. 11, lines 42-46). The location information may be sent before, during, or after the device communicates with an answering point regarding an emergency telephone call. Walsh does not disclose or suggest receiving an activation request. In contrast, the claimed invention broadcasts the respective geographical location information upon receipt of an activation request from a request subsystem.

In addition, Walsh merely discloses the cellular telephone 104 receives the location information, not being enabled by a processor. In contrast, claim 54 recites, in part, "a processor . . . to enable the receiver to receive the location information."

Furthermore, Walsh merely discloses the location information associated with a plurality of predetermined areas in the facility such as a floor, a room, etc. (Walsh, col. 10, lines 42-44, lines 54-59), not the respective geographical location information, i.e., the geographical location information of the transmitters.

Moreover, Walsh merely discloses a controller to receive location information from a location entry device (Walsh, col. 10, lines 42-45), not in response to a telephony call. The location entry device provides pre-determined location information such as manually by a keyboard or voice recognition program, or from a database, or by a GPS receiver (Walsh, col. 11, lines 23-34). Therefore, the location information is merely provided in advance in an off-line manner, not in response to a telephony call, or not using a location sensor and a determination unit, as recited in claim 60.

Jones merely discloses activating a user as entering the user into the system (Jones, paragraph [0063], lines 3-4; paragraph [0066], lines 3-5). An activation request, therefore, is a request to enter the user into the system, not a request for geographical location information. Furthermore, the activation request is generated by the user, not by a request subsystem in response to a telephony call.

A combination of Walsh and Jones is therefore improper because Walsh cannot be modified to incorporate the teaching of Jones when Jones does not disclose or suggest any application using transmitter or receiver or an activation request to request for geographical location information. The Examiner even admits that the combination of Walsh and Jones does not specifically disclose an information message containing respective geographical location information of the transmitter (Office Action, page 10, lines 3-5). Accordingly, a combination of Walsh and Jones and Gerhart is improper because a combination of Walsh and Jones does not disclose or suggest an information message containing respective geographical location information of the transmitter.

Furthermore, as discussed above, Gerhart merely discloses a transmitted message normally containing the location of the transmitting station (Gerhart, col. 6, lines 1-7), not an information message containing a geographical location of a transmitter containing the transmitting unit. First, the transmitted message is displayed when an alarm condition is signaled (Gerhart, col. 6, lines 1-2), not in response to a telephony call. Second, a transmitting station is

not a transmitter. The transmitting station may be a house, a dwelling, or a building (Gerhart, col. 1, lines 26-29). Third, the location may not be a geographical location. It may be a number coded to indicate the position of the transmitting station in a display of a network of stations.

5. Claims 33-37:

Walsh, Jones, and Gerhart are discussed above.

Norman discloses a network communication system with information rerouting capabilities. Access points provide wireless access to the system reroute misrouted information packets in the event the location of a mobile unit has changed (Norman, col. 3, lines 52-55). A "current location" table is maintained in the memory of each access point to keep track of when mobile units are currently located (Norman, col. 3, lines 64-66).

Walsh, Jones, Gerhart, and Norman, taken alone or in combination, do not disclose, suggest, or render obvious at least one of: (1) a network component capable of sensing at least one of the plurality of transmitters, the network component comprising: a sensor capable of at least intermittent coupling to a first transmitter of the plurality of transmitters to receive the respective geographical location broadcast by the first transmitter, a location determination unit coupled to the sensor to process the received respective geographical location information, and a network interface to externally issue the respective geographical location information in accordance with a packet data format; as recited in claim 33; (2a) a server coupled to the plurality of transmitters to selectively issue the activation request to the plurality of transmitters responsive to a location event, and (2b) a packet network interposing the network interface of the network component and the server, the packet network to bear the packetized, respective geographical location information to said server; as recited in claim 34; (3) the location event is generated by the network component, as recited in claim 35; (4) the location event comprises an emergency call, as recited in claim 36; and (5) an e-commerce transaction processor coupled to the packet network, wherein the location event is generated by the e-commerce transaction processor, as recited in claim 37.

As discussed above, Walsh merely discloses a controller to receive location information from a location entry device (Walsh, col. 10, lines 42-45), not in response to a location information request. In addition, Walsh does not disclose a network interface to externally issue the respective location. Furthermore, Jones merely discloses activating a user as entering the

user into the system (Jones, paragraph [0063], lines 3-4; paragraph [0066], lines 3-5). An activation request, therefore, is a request to enter the user into the system, not a request for geographical location information. Furthermore, the activation request is generated by the user, not by a request subsystem in response to a telephony call. Accordingly, a combination of Walsh and Jones with any other references in rejecting claims 33-37 is improper.

Furthermore, as discussed above, Gerhart merely discloses a transmitted message normally containing the location of the transmitting station (Gerhart, col. 6, lines 1-7), not an information message containing a geographical location of a transmitter containing the transmitting unit. First, the transmitted message is displayed when an alarm condition is signaled (Gerhart, col. 6, lines 1-2), not in response to a telephony call. Second, a transmitting station is not a transmitter. The transmitting station may be a house, a dwelling, or a building (Gerhart, col. 1, lines 26-29). Third, the location may not be a geographical location. It may be a number coded to indicate the position of the transmitting station in a display of a network of stations.

Moreover, Norman merely discloses the location information representing the route from the access point to the respective access point to which the mobile unit is registered (Norman, col. 11, lines 38-40). The route is not a geographical location information because it only shows the source and destination (Norman, col. 11, lines 36-37). Norman merely discloses the access points broadcasting onto the network 32 an updated current location information packet to each of the other access points 42 (Norman, col. 17, lines 41-44). The current location information merely refers to the location of the mobile units being the access points (Norman, col. 14, lines 56-59), not geographical location information.

None of Walsh, Jones, Gerhart, and Norman discloses or suggests an e-commerce transaction processor generating the location event. The Examiner contends that such feature is well known in the art (Office Action, page 15, lines 13-14). Applicants submit that such an official notice is inappropriate.

Official notice unsupported by documenting evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970); MPEP 2144.03A. It would not be appropriate for the Examiner to take official notice of facts without citing a prior art references. MPEP

2144.03A. Furthermore, if official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable. MPEP 2144.03B.

Here, none of Walsh, Jones, Gerhart, and Norman discloses or suggests an e-commerce transaction processor generating the location event. The Examiner did not provide a technical line of reasoning which must be clear and unmistakable. The Examiner merely states that “such feature is well known in the art” (Office Action, page 15, lines 13-14). Such a conclusory statement is not a reasoning. Therefore, the Examiner’s reasoning is unclear and not unmistakable.

6. Claims 38-53:

Walsh, Jones, and Norman are discussed above.

Walsh, Jones, and Norman, taken alone or in combination, do not disclose, suggest, or render obvious at least one of: (1) receiving a location information request from a request subsystem in response to a telephone call, the location information request requiring a geographical location information; (2) generating at least one data packet comprising the geographical location information; and (3) transmitting the at least one data packet upon receipt to a network of an activation command in response to the location information request, as recited in claim 38.

As discussed above, Walsh merely discloses a controller to receive location information from a location entry device (Walsh, col. 10, lines 42-45), not receiving a location information request. In addition, Walsh merely discloses the location information associated with a plurality of predetermined areas in the facility such as a floor, a room, etc. (Walsh, col. 10, lines 42-44, lines 54-59), not the geographical location information. Furthermore, Jones merely discloses activating a user as entering the user into the system (Jones, paragraph [0063], lines 3-4; paragraph [0066], lines 3-5). An activation request, therefore, is a request to enter the user into the system, not a request for geographical location information. Furthermore, the activation request is generated by the user, not by a request subsystem in response to a telephony call. Accordingly, a combination of Walsh and Jones with any other references in rejecting claims 38-53 is improper.

Moreover, Norman merely discloses the location information representing the route from the access point to the respective access point to which the mobile unit is registered (Norman, col. 11, lines 38-40). The route is not a geographical location information because it only shows the source and destination (Norman, col. 11, lines 36-37). Norman merely discloses the access points broadcasting onto the network 32 an updated current location information packet to each of the other access points 42 (Norman, col. 17, lines 41-44). The current location information merely refers to the location of the mobile units being the access points (Norman, col. 14, lines 56-59), not geographical location information.

In summary, there is no motivation to combine Buhrmann, Nelms, Bjork, Jones, Gerhart, Norman, and Walsh because none of them addresses the problem of automatic remote communication using network telephony. There is no teaching or suggestion that, among others, decoding an activation message, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the information message containing a geographical location, a network component capable of sensing at least one of the plurality of transmitters, the network component comprising: a sensor capable of at least intermittent coupling to a first transmitter of the plurality of transmitters to receive the respective geographical location broadcast by the first transmitter, modulating the information message according to a modulating scheme using a pseudo random binary sound (PRBS), the location identifier including the global positioning system (GPS) information, the telephony call being made by a person located in proximity of the location of the transmitting unit, a location determination unit to process the received respective location information, or a packet network to bear the packetized, respective location information is present. None of Buhrmann, Nelms, Bjork, Jones, Gerhart, Norman, and Walsh, read as a whole, suggests the desirability of any of the above elements. For the above reasons, the rejections under 35 U.S.C. §103(a) are improperly made.

The Examiner failed to establish a prima facie case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be

viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited

references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of any combination of Buhrmann, Nelms, Bjork, Jones, Gerhart, Norman, and Walsh.

In the present invention, the cited references do not expressly or implicitly suggest any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Buhrmann, Nelms, Bjork, Jones, Gerhart, Norman, and Walsh is an obvious application of automatic remote communication using network telephony.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, and 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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